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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/720,070	09/27/1996	RICHARD G HYATT JR.	P53821C	1185

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EXAMINER

BARRETT, SUZANNE LALE DINO

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/720,070

Applicant(s)

HYATT, RICHARD G

Examiner

Suzanne Dino Barrett

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56, 64-116 and 119-121 is/are pending in the application.
- 4a) Of the above claim(s) 43-45, 73 and 94 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-33, 39-42, 55, 78-84 and 107 is/are allowed.
- 6) ☒ Claim(s) 1-24, 34-38, 46-52, 54, 56, 64-70, 75-77, 85, 88-106, 108, 109, 111-116, 119-121 is/are rejected.
- 7) ☒ Claim(s) 53, 71, 72, 74, 86, 87 and 110 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 46, 48.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3676

DETAILED ACTION

Applicant is reminded that an analysis under 37 C.F.R. 1.607(a) is still requested. In this regard, please note that a miscellaneous letter with a thirty day time period set for response is being mailed simultaneously.

Election/Restrictions

1. Claims 43-45, 73, 94 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Drawings

2. The corrected or substitute drawings were received on 2/24/03. These drawings are approved.

Claim Rejections - 35 USC § 112

3. Claims 11-13, 90 and 120 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the instant specification fails to provide support for the "at least one electromechanical locking member" and "plurality of electromechanical locking members" set forth in claims 90 and 120, respectively.

Art Unit: 3676

This rejection stands since, firstly, the solenoid coils 109 argued on page 69 of the amendment are not disclosed "locking members". Secondly, the specification discloses that the "plurality" of locking members 106a, 107a, 108a are used alternatively and not as a plurality within the same plug. See the specification on page 12, lines 11-13 which clearly recites the use of locking member 106a or 107a or 108a.

Additionally, amended claim 11 sets forth, in the last two lines, the phrase "distal member... distal member", which is not understood (how can the distal member surround itself?).

4. Claims 1-5, 6-10, 14-24, 35-38, 70-74, 106, 111, 121 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 11, the phrase "for relative to movement" is grammatically improper and not understood. In claim 6, line 20, "locking means" should be --locking device--for proper antecedent basis. In claim 14, line 6, "said first end and second end" lack antecedent basis. In claim 70, line 12, "logical" should be changed to --logic--for proper antecedent basis. In claim 121, line 6, "said cylinder plug detent" lacks antecedent basis.

Note that the claims not specifically discussed are included herein merely because of their dependency. **Further note that the rejection of claims 6, 14 and 70 is reiterated since it was not addressed in the pending amendment.**

Art Unit: 3676

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-5, 11-13, 34, 65-69, 75, 85, 89, 92-104, 112, 121 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-78 of U.S. Patent No. 6,564,601. Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely recite like elements using different terminology and/or phraseology such as "detent" instead of "bar". It is noted that claims 1 and 11 recite a "detent", but not a "stationary detent", and thus, the side bar detent of the patent reads on this limitation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 46-52, 54, 56, 64, 70, 76, 77, 85, 88-91, 105, 108, 109, 111, 113-116, 119, 120, and 121 as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gokcebay 5,552,777 in view of Thordmark et al 5,542,274 and Naveda 4,416,127.

Applicant is referred to paragraph 5 of the office action of 11/13/00 (paper no. 39) for a complete discussion of the prior art rejection. It is noted that these claims have not been amended.

Allowable Subject Matter

9. Claims 25-33, 39-42, 55, 78-84, 107 are allowed.

10. Claims 6-10, 14-24, 35-38, 106 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The "stationary detent", in combination with the claimed limitations, is not found nor suggested by the prior art of record.

Response to Arguments

11. Applicant's arguments with respect to claims 1-56, 64-116, 119-121 have been considered but are moot in view of the new ground(s) of rejection.

As set forth above, several rejections still stand, while several new rejections are made under 35 USC 112. Furthermore, the following issues are noted: (1) Applicant has not cancelled the interference claims as agreed upon in the interview of paper no. 48. (2) Applicant has not addressed the double patenting rejection of the claims set forth in

Art Unit: 3676

paragraph 6 above, and also, with respect to claims 1 and 11, has not overcome the rejection since the "detent" is not claimed as "stationary" and therefore reads on the sidebar of the patented claim. (3) Applicant has broadened claims 1 and 11 and, it is noted that, contrary to the remarks on page 70, line 13 of the amendment, has failed to incorporate the "stationary" detent limitation. (4) With respect to the rejection under 35 USC 112, 1st paragraph of claims 90 and 120, this rejection stands for the reasons set forth in paragraph 2 above. Accordingly, the aforementioned claims stand finally rejected.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3676

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 703-308-0825. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1020.



Suzanne Dino Barrett
Primary Examiner
Art Unit 3676

sdb
June 12, 2003